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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,010	06/20/2000	Antoine Bastard	P/3255-43	5043
2352	7590	04/18/2005	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			LAZOR, MICHELLE A	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 04/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,010

Applicant(s)

BASTARD ET AL.

Examiner

Michelle A. Lazor

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-54 is/are pending in the application.
- 4a) Of the above claim(s) 42-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,27-30,36 and 40 is/are rejected.
- 7) ☒ Claim(s) 19,21-26,31-35 and 37-39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Claims 19-41 in the reply filed on 3/24/05 is acknowledged. The traversal is on the ground(s) that the method claims are not independent and distinct from the product claims. This is not found persuasive because as stated in the Office Action mailed 12/20/04, the compound placed in the annular region can remain uncured.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the separating elements must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will

Art Unit: 1734

be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: (9") on page 7, line 18, and (19) on page 9, last line. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 20, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picking (U.S. Patent No. 5860453) in view of Ziu (U.S. Patent No. 4786088) and Martin, Jr. et al. (U.S. Patent No. 4522578).

Regarding Claims 20, 40 and 41, Picking discloses a method of manufacturing a reelable double-walled pipe comprising an inner flow pipe, an outer carrier pipe which surrounds the

Art Unit: 1734

flow pipe, and a plurality of separating elements between the inner and outer pipes which define an annular space therebetween (Figures 1 and 2), the method comprising having suitable mechanical properties which permit the double walled pipe to be plastically deformed for reeling on a vessel reel and then straightened while being laid offshore; installing a plurality of sealing blocks axially spaced apart on the outer wall of the flow pipe including a plurality of pairs of axially spaced sealing blocks, thereby defining a plurality of annular regions, installing the outer carrier pipe around the flow pipe and the sealing blocks, the sealing blocks having radially opposite faces and being dimensioned to be in contact respectively with the outer and inner walls of the flow pipe and the carrier pipe to define at least one sealed annular regions within the space between the flow pipe and the carrier pipe (column 2, lines 11 – 33); and spacing the sealing blocks so that the axial length of the annular region is in the range of 0.5 times the external diameter of the carrier pipe (Figure 2). Although Picking only shows one block, the other must be spaced so that it is outside the drawing, and thus meets the claimed limitation. But Picking does not specifically disclose selecting the material of the inner pipe and outer pipe to be reflective of the properties of the fluid to be transported and the intended environment of use, respectively; and although Picking discloses filling the pipe with a thermally insulating material that increases the strength of the pipe (column 1, lines 10 – 27), he does not specifically disclose a curable compound being placed in the annular region, and curing the compound. However, Ziu discloses selecting the material of the inner pipe and outer pipe to be reflective of the properties of the fluid to be transported and the intended environment of use, respectively (column 5, lines 43 – 51); and Martin, Jr. et al. teaches using a curable, insulating compound being placed in an annular region, and curing the compound (column 1, lines 9 – 20). Therefore it would have been

Art Unit: 1734

obvious to one of ordinary skill in the art at the time of the invention to select the material of the inner pipe and outer pipe to be reflective of the properties of the fluid to be transported and the intended environment of use, respectively, to reflect the required performance characteristics and avoid any potential leaking from harsh chemicals (column 5, lines 44 – 48); and it would have been obvious to use a curable compound being placed in an annular region, and curing the compound since it is well known and conventional to use a curable foaming compound and curing the compound, to obtain an insulated fluid conduit (column 1, lines 9 – 13).

6. Claims 27, 28, 30, 36 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Picking, Ziu, and Martin, Jr. et al. as applied in Claim 40 above, in view of Pool et al. (U.S. Patent No. 6402201).

Regarding Claims 27, 30, and 36, Picking, Ziu, and Martin, Jr. et al. disclose all the limitations of Claim 40, but do not specifically disclose an epoxy resin or a polymer to fill the empty annular space that is curable at room temperature and has a pot life range of a few minutes to a few weeks. However, Pool et al. is considered to disclose an epoxy resin or a polymer (column 4, lines 52 – 57) to fill the empty annular space that is curable at room temperature and has a pot life range of a few minutes to a few weeks (column 5, lines 4 – 17). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use an epoxy resin or a polymer in the annular space since it is quick hardening (column 4, lines 56 – 57); and it would have been obvious to cure the polymer or compound at room temperature and have a pot life of a few minutes to a few weeks to simplify the method of filling the annular space, requiring less time and machinery to adequately fill the annular space.

Art Unit: 1734

Regarding Claim 28, Pool et al. disclose the steps of providing an injection orifice through the wall of the carrier pipe into the region and injecting the curable compound into the region through the orifice (Figures 2 – 4; column 4, lines 27 – 34). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide an injection orifice through the wall of the carrier pipe into the region and inject the curable compound into the region through the orifice to facilitate filling the annular space with the curable compound.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Picking, Ziu, Martin, Jr. et al. and Pool et al. as applied in Claim 28 above, in view of Stevens (U.S. Patent No. 5474721).

Regarding Claim 29, Picking, Ziu, Martin, Jr. et al., and Pool et al. disclose all the limitations of Claim 28, but do not specifically disclose using a thermosetting compound. However, Stevens discloses using a thermosetting compound in an annular region (column 2, line 49 – column 3, line 20). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a thermosetting compound as an alternative curable compound.

Allowable Subject Matter

8. Claims 19, 21 – 26, 34, 35, and 37 – 39 are objected to, but would be considered allowable as discussed in the Office Action mailed 5/17/04.

Response to Arguments

9. Regarding the arguments presented by the Applicant referring to the election of the method claims, Examiner disagrees. As discussed above, it is not unrealistic to place a curable compound in an annular region and not cure the compound.

Art Unit: 1734

10. Regarding the arguments presented by the Applicant referring to the prior art rejections, Examiner disagrees. Although Picking may not specifically use the word “buckling” or may not refer to using the method taught for offshore pipelines, the modified method suggested by Picking is considered to be capable of avoiding buckling and for being used for underwater pipelines, as claimed. Offshore pipelines, as referred to by the Applicant, is not commensurate in scope with the claims, and therefore has not been considered.

11. Applicant's arguments with respect to claim 40 have been considered but are moot in view of the new ground(s) of rejection by the addition of Martin, Jr. et al. In addition, as stated in the Office Action mailed 12/20/04, there is motivation to combine the Picking and Ziu references as stated above: it would have been obvious to one of ordinary skill in the art at the time of the invention to select the material of the inner pipe and outer pipe to be reflective of the properties of the fluid to be transported and the intended environment of use, respectively, to reflect the required performance characteristics and avoid any potential leaking from harsh chemicals (Ziu; column 5, lines 44 – 48).

With respect to substituting the rubber gasket in Picking for a curable compound, that was never the intention of the Examiner. Picking was included to show sealing blocks or rubber gaskets (2) that define a sealed annular region within the annular space, that include separating elements or annular steel rings (5). And as stated above, although Picking only shows one block, the other must be spaced so that it is outside the drawing, and thus meets the claimed limitation as shown in Figure 2.

Conclusion

Art Unit: 1734

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Watkins (U.S. Patent No. 6058979) discloses a subsea insulated pipeline (Abstract; Figures 2 and 5).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A. Lazor whose telephone number is 571-272-1232. The examiner can normally be reached on Wed - Thurs 5:45 - 4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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